

## **REMARKS**

Claims 1, 2 and 11-21 are pending in the application. Applicant notes that claim 21 was not addressed by the Examiner in the current office action. Claims 1 and 17-20 stand rejected. Claims 2 and 11-16 have been allowed. The drawings have been objected to.

### **Objections to the Drawings**

The Examiner objects to the drawings under 37 CFR §1.83(a) for failing to show every feature of the invention specified in the claims. Specifically, the Examiner contends that "the plug seal between the production valve and the point of well fluid entry into the production tubing" must be shown or the feature(s) cancelled from the claims. In response, Applicant is amending claim 2 to remove the reference to the location of the plug seal. Applicant submits that this is not a narrowing amendment of the claims, and that claims 2 and 12-16 continue to recite allowable subject matter after the amendment.

### **Rejection of Claim 1 under 35 USC §102(b) over White and Brandell**

Claim 1 stands rejected for anticipation under 35 U.S.C. 102(b) over both White (U.S. 2,083,625) and Brandell et al. (U.S. 5,117,910). The Examiner contends that White teaches the steps of positioning production tubing; cementing above the production zone (e.g. at 34); purging all cement; and opening the internal bore by fluid displacement (by displacement of plug 28-see fig. 8) as called for in claim 1. Further, he considers Brandell to teach the steps of positioning production tubing; cementing above the production zone; purging all cement; and opening the internal bore by fluid displacement as called for in claim 1.

In response, Applicant notes that it has amended claim 1 herein to recite a method of producing a well wherein the well fluid production tubing includes a pressure activated production valve and the production valve is positioned proximate a production formation. Applicant submits that neither White nor Brandell teaches or suggest the use of such a production valve. In White, production fluid enters the production tubing through a lateral screen 12 or perforations 36. In Brandell, the production fluid presumably enters the production tubing via the lower end of the production string (i.e., through seat member 56). Neither reference discloses or suggests a valve or any method of activating such a valve. Because at least this step is not disclosed or suggested by White or Brandell, Applicant submits that claim 1 recites patentable subject matter.

#### **Rejection of Claims 17-19 under 35 USC §102(b) over Baker**

Claims 17-19 are rejected under 35 U.S.C. 102(b) as being anticipated by the Baker reference (U.S. 3,948,322). The Examiner considers Baker to teach the steps of positioning, inflating, pumping, and closing as called for in claim 17. He also considers Baker to teach the steps of disposing a plug and increasing pressure as called for in claim 18 and delivering a plug as called for in claim 19.

Applicant traverses the rejection as it might apply to the claims as amended herein. As amended, claims 17-19 recite a method wherein fluid pressure is increased within the production tubing to open a production valve. At least this step is not disclosed or suggested by the Baker reference. In Baker, there is no production valve, and, for subsequent operations, the cement must be drilled through (see Baker, col. 11, lines 9-15).

#### **Rejection of Claims 17-19 under 35 USC §103 over Brandell and Baker**

Claims 17-19 also stand rejected under 35 U.S.C. 103(a) as being unpatentable over Brandell, et al. in view of Baker (U.S. 3,948,322). The Examiner contends that Brandell teaches the positioning tubing, pumping cement, and closing a cementing valve. The Examiner admits that Brandell fails to teach the step of inflating a packer. He notes, however, that Baker teaches a similar process, and teaches inflating a packer. He contends that one of skill in the art would be motivated to modify Brandell to use an inflatable packer, as taught by Baker, because an inflatable packer provides a better seal.

Applicant submits that claim 17, as amended, recites a method wherein a production valve is opened. Neither Baker nor Brandell teaches at least this step.

#### **Rejection of Claim 20 under 35 USC §103 over Brandell, Baker, and Richard**

Claim 20 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Brandell and Baker as applied to claim 17 above, and further in view of Richard et al. (U.S. 5,598,890). The Examiner considers the combination of Brandell and Baker to teach all of the elements of claim 20 except for the step of increasing pressure to open a production valve. He contends, however, that Richard teaches a similar process and that a production valve is useful to prevent contamination of production pathways. The Examiner admits that Richard opens its production valve with a shifting tool using known methods. He then takes "official notice" that increasing fluid pressure is a known method of opening a valve with a shifting tool. He then concludes that it would have been obvious to one of ordinary skill in

the art at the time of the invention to have further modified the Brandell process to have included increasing pressure to open production valve as called for in claim 20, since use of a production valve prevents contamination of production pathways.

Applicant notes that claim 20 has been cancelled herein, but its subject matter has been imported into claim 17. To the extent that it applies to claims 17-19 and 21, Applicant traverses the rejection. Pursuant to MPEP §2144.03C, Applicant challenges the Examiner's assertion that increasing fluid pressure is a known method of opening a valve with a shifting tool. Pursuant to that section, Applicant requests that the Examiner produce documentary proof in support of his position. In the Richard device, the sleeve valve 23 is opened and closed using a shifting tool S (see e.g., Richard, col. 2, lines 39-44). There is no teaching or suggestion in the reference that the sleeve valve 23 is operable in response to increased fluid pressure. Because at least this step is not taught or suggested by the art, Applicant submits that the rejection should be withdrawn.

#### **CONCLUSION**

Applicant submits that the application is in condition for allowance and urges the Examiner to pass the case to issue. The Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0429 (284-23258-USD).

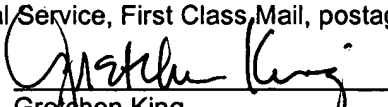
Respectfully submitted,

Dated: September 13, 2004

  
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#### **CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)**

I hereby certify that this paper, along with any referred to as being attached or enclosed, is being mailed to the Attention: MS: Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, via the United States Postal Service, First Class Mail, postage prepaid on this 13th day of September, 2004.

  
Gretchen King